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Response Under 37 C.F.R. 1.116 - Expedited Procedure
Examining Group 1643

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Goli et al.

Title: NOVEL HUMAN CYTOKINE/STEROID RECEPTOR PROTEIN

Serial No.: 09/203,548 Filing Date: December 01, 1998

Examiner: Pak, M. Group Art Unit: 1643

Box AF
Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO NOTIFICATION OF NON-COMPLIANCE WITH 37 CFR 1.192(c)

Sir:

This is in response to the Notification of Non-Compliance with 37 CFR 1.192(c) mailed May 21, 2002, in the above-referenced application.

The Examiner asserts that the Appeal Brief for the above-referenced application is defective because it does not contain a statement of the status of the Amendment After Final which was submitted September 18, 2001. Appellants respectfully note that the Appeal Brief does contain a statement of the status of this Amendment After Final, stating that the Examiner had agreed in a telephone interview to enter the Amendment. The entry of this Amendment was then officially indicated in the Advisory Action mailed December 13, 2001 (after the filing of the Appeal Brief on September 18, 2001). Section #4, "Status of Amendments After Final," has been corrected to reflect this update in status of the Amendment.

The Examiner further asserts that the Appeal Brief is defective because it allegedly does not contain a concise explanation of the claimed invention, referring to the specification by page and line number. Specifically, the Examiner asserts that the last paragraph of the Summary discusses the

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study of progesterone function which was not mentioned in the specification. Appellants respectfully note that the utility of the claimed invention in the study of progesterone function through membrane-bound receptors follows logically from the identification of the claimed polypeptide as a membrane bound progesterone receptor, which is discussed in multiple places in the specification as indicated by the citations in the Summary. However, in order to expedite the Appeal, the statement regarding study of progesterone function has been removed from the Summary.

Finally, the Examiner asserts that the Appeal Brief is defective because it contains a subsection #6, with the heading "The Final Rejection" for which there is no provision in the MPEP. Appellants respectfully point out that, as stated in the MPEP, § 1206, "37 CFR 1.192(c) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. A brief is in compliance with 37 CFR 1.192(c) as long as it includes items (1) to (9) in the order set forth." Thus there is no requirement that Appellants remove subsection #6 from the Appeal Brief, and Appellants have chosen to retain this subsection, which contains a useful summary of the issues raised in the Final Rejection.

Appellants submit herein three copies of a new Appeal Brief, with the status of the Amendment After Final updated (subsection #4) and the discussion of the study of progesterone function removed (subsection #5) as requested by the Examiner. No other changes have been made to the Appeal Brief. Appellants believe that this Appeal Brief is fully in compliance with 37 CFR 1.192(c).

Appellants note that this is the second Notification of Non-Compliance received in connection with this application. The first one was mailed December 18, 2001 and did not mention any of the issues raised in the current Notification of Non-Compliance, although there was no reason why these issues could not have been raised at that time. Appellants assume that there are no further issues of form regarding the instant Appeal Brief, and that the processing of this appeal will proceed with an Examiner's Answer to Appellants' brief.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108.**

Respectfully submitted,

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Date: June 21, 2002

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